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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/806,179	03/23/2004	Atsushi Koyama	P25085	2010
7055	7590	02/02/2006	EXAMINER ~	
GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			HECKENBERG JR, DONALD H	
			ART UNIT	PAPER NUMBER

1722

DATE MAILED: 02/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/806,179	KOYAMA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Donald Heckenberg	1722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some    \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Art Unit: 1722

1. A request for continued examination (RCE) under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office Action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 05 December 2005 has been entered.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 2, and 4 are rejected under 35 U.S.C. 102(e) as being anticipated by Japanese Pub. No. 10-302328 (previously of record; hereinafter "JP '328").

JP '328 discloses a molding apparatus for making optical disc substrates. The mold comprises a flat disk-shaped

Art Unit: 1722

stamper (111) having a molding surface for forming micro asperities in a surface of the molded substrate. In the embodiment depicted in Figure 3, the mold further comprises a stamper holder (119) that is fitted in an insertion hole extending through a central portion stamper (see Fig. 3). The stamper holder (119) is configured such that an outer periphery (115) of the stamper holder has a gradually increased diameter on a side toward the molding surface compared to the reserves side thereof, thus forming a sloped surface (see Fig. 3). The stamper (111) has an inner peripheral surface defining an insertion hole in a shape entirely complimentary to the inner peripheral surface of the stamper; that is, where the surface of the holder is sloped, the corresponding surface of the stamper is sloped, and where the surface of the stamper holder is straight, the corresponding surface of the stamper is straight (see Fig. 3).

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the

Art Unit: 1722

art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. The factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Art Unit: 1722

7. Claims 3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP '328.

JP '328 discloses the apparatus as described above, notably including an embodiment depicted in Fig. 3 in which the stamper and stamper holder include corresponding sloped surfaces. The embodiment of Fig. 3 does not show the stamper holder to be configured such that an end face of the stamper holder on a cavity side is flush with the molding surface. In another embodiment, however, JP '328 disclose a configuration of the apparatus in which the stamper holder (122) does have an end face on the cavity side flush with the molding surface (see Fig. 4). Thus, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have modified the apparatus disclosed by JP '328 in the embodiment depicted in Fig. 3 as such to have the stamper holder configured that an end face of the stamper holder on a cavity side is flush with the molding surface because JP '328 suggests that such a configuration of the stamper holder is a suitable alternative for the construction of the apparatus. Note further, such a modification would require merely a change in the shape of the apparatus structure. Normally, a change in the form or shape of a prior art structure is seen as an obvious modification to one of ordinary skill in the art unless it can be shown there is a

Art Unit: 1722

new and unexpected result. In re Dailey, 357 F.2d 669, 672-73, 149 USPQ 47, 50 (CCPA 1966).

8. Applicant's arguments filed 05 December 2005 have been fully considered but they are not persuasive.

Applicant argues that JP '328 fails to teach or suggest the subject matter as now recited in claims 1, 2, and 4. Specifically, Applicant contends that JP '328 does not disclose "an outer periphery of the stamper holder having a gradually increased diameter from an end of a reverse side toward an end of the molding structure to form a sloped surface, an entire outer peripheral surface of the stamper holder opposite to an inner peripheral surface of the stamper defining an insertion hole that has a shape complementary to the inner peripheral surface of the stamper." Applicant argues that JP '328 instead discloses only a part of the inner peripheral surface of the stamper holder to be configured to be sloped. Applicant also asserts that the only a portion of the periphery of the stamper holder has a shape complementary to the inner peripheral surface of the stamper.

As described above, JP '328 does disclose all of the features of claims 1, 2, and 4. The stamper holder of JP '328 comprises an increased diameter portion resulting in a sloped

Art Unit: 1722

surface (see Fig. 3). Further, the outer peripheral surface of the stamper holder has a shape that is entirely complementary to that of the inner portion of the stamper which sits opposite to it - where the surface of the holder is sloped, the corresponding surface of the stamper is sloped, and where the surface of the stamper holder is straight, the corresponding surface of the stamper is straight (see Fig. 3). That the sloped surface disclosed by JP '328 is only a portion of the surface of the stamper holder that contacts the stamper does not distinguish the reference from the claims of the instant application. The amended claim language requires only that the stamper holder have a sloped surface portion, and that the shape of the stamper holder surface be entirely complementary to that of the inner peripheral surface of the stamper opposite to it. The language of the claims does not require, as it appears that Applicant is trying to assert, that the entire portion of the stamper holder which is complementary to the inner peripheral surface of the stamper be sloped. While such a limitation may not be suggested by JP '328, the language as it now stands merely requires both a surface of the stamper holder to be sloped, and then that the shape of the corresponding surfaces of the stamper holder and stamper to be entirely complementary. JP '328 discloses both of these features.



Art Unit: 1722

With respect to claims 3 and 5, Applicant argues that there is not sufficient motivation to modify the disclosure of JP '328, and thus the rejection is based only on impermissible hindsight.

Applicant's argument is not found persuasive. As described in the rejection of claims 3 and 5, JP '328 discloses alternative configurations for the stamper holder, including its end features. As such, the reference suggests modifications to render the features of claims 3 and 5 obvious.


9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Heckenberg whose telephone number is (571) 272-1131. The examiner can normally be reached on Monday through Friday from 9:30 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith, can be reached at (571) 272-1166. The official fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

Art Unit: 1722

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <<<http://pair-direct.uspto.gov>>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

  
Donald Heckenberg  
Primary Examiner  
A.U. 1722

1-31-6